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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/231,854 01/14/99 MARTINELLI

M MRTK-001RE

QM32/0630

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EXAMINER

SHAW, S

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 06/30/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
09/231,854

Attendant(s)

Martinelli

Examiner

Shawna J. Shaw

Group Art Unit

3737



Responsive to communication(s) filed on Jan 26, 2000

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

Claim(s) 1-25 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-22 is/are allowed.

Claim(s) 23-25 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 1/26/2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/231,854 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Allowable Subject Matter***

2. Claims 1-22 are allowed.

The indicated allowability of claims 23-25 is withdrawn in view of the newly discovered reference(s) to Shapiro et al. of record and Ben-Haim '951. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 23 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Shapiro et al. '367 of record.

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Shapiro et al. disclose a method for determining a catheter depth, position and orientation including: inducing a set of orientation values within at least one sensing coil (214, 216, 218), determining the orientation of the at least one sensing coil, inducing a set of position values within the at least one sensing coil and determining the position of the at least one sensing coil using the positional signal values and the determined orientation. See col. 2 lines 41-53, col. 3 lines 6-23, col. 3 lines 37-40, col. 4 lines 6-34, col. 4 line 68 - col. 5 line 4, col. 6 lines 20-30, and col. 9 lines 20-29.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. '367 in view of Ben-Haim '951.

In regard to claim 25, Shapiro et al. disclose a method for determining a catheter depth, position and orientation including: inducing a set of orientation values within at least one sensing coil (214, 216, 218), determining the orientation of the at least one sensing coil, inducing a set of position values within the at least one sensing coil and determining the position of the at least one sensing coil using the positional signal values and the determined orientation. See col. 2 lines 41-53, col. 3 lines 6-23, col. 3 lines 37-40, col. 4 lines 6-34, col. 4 line 68 - col. 5 line 4, col. 6 lines

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20-30, and col. 9 lines 20-29. Shapiro et al. differ from the claimed invention in that a plurality of catheters are not specifically addressed. Ben-Haim et al. disclose a method for tracking a plurality of device and reference catheters within a patient's body. See col. 3 lines 41-59, col. 9 lines 19-42, col. 10 lines 9-43, col. 11 lines 27-51 and col. 12 lines 29-49. It would have therefore been obvious at the time the invention was made to a person of ordinary skill in the art to track more than one catheter as taught by Ben-Haim in the invention as taught by Shapiro et al. to provide a more accurate and efficient means for performing a medical procedure.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawna J. Shaw whose telephone number is (703) 308-2985. The examiner can normally be reached on Monday - Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin Lateef, can be reached on (703) 308-3256. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

SJS   
2/24/00



Marvin M. Lateef  
Supervisory Patent Examiner  
Group 3700